

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Huebner et al.

Application No.: 10/713,621

Filed: November 13, 2003

Title: ESTROGEN RECEPTOR MODULATORS

Attorney Docket No.:
1534.207/CHIRP018AD1C2

Examiner: D. Lambkin

Group: 1626

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first-class mail on July 30, 2004 in an envelope addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Signed: _____

Jeanne Lupton

RESPONSE

Mail Stop Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action mailed June 21, 2004 in the above-referenced application. Claims 1-9 are pending in the application.

Double Patenting

Claims 1-9 have been rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-9 of commonly-owned US Patent No. 6,743,815 (statutory double patenting), the parent of the present application. This rejection is respectfully traversed since the scope of claim 1 of the present application differs from that of claim 1 of 6,743,815. In particular, claim 1 of the present application recites that R₁ is optionally substituted *p*-hydroxyphenyl while claim 1 of 6,743,815 recites that R₁ is optionally substituted *p*-hydroxyphenyl or loweralkoxyphenyl. As such, claim 1 of the present invention does not allow the possibility that R₁ is a loweralkoxyphenyl and thus claims a different invention than claim 1 of 6,743,815. Claims 2-9 of the present application depend directly or indirectly from claim 1 and are thus submitted to be patentable for the same reason. Accordingly, it is respectfully submitted that the statutory double patenting rejection be withdrawn.

Claim 1 is rejected under the judicially created doctrine of obvious-type double patenting over claim 1 of commonly-owned U.S. Patent No. 6,262,098, the grandparent of the present application.

A terminal disclaimer over both the parent and grandparent patents cited in these rejections is filed herewith in order to overcome the stated obviousness-type double patenting rejection with regard to the grandparent application and also to address a potential obviousness-type double patenting issue with regard to the parent application now that the statutory double patent rejection has been addressed. It is respectfully submitted that this terminal disclaimer places the application in condition for allowance.

Power of Attorney

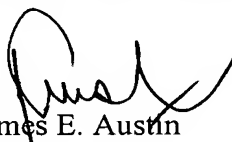
A Power of Attorney accompanies this filing.

Conclusion

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at (510) 843-6200. If any further fees are due in connection with the filing of this amendment, the Commissioner is authorized to charge such fees to Deposit Account 500388 (Order No. CHIRP018AD1C2).

Please direct all correspondence to the **correspondence address** indicated below with Customer Number **27476**.

Respectfully submitted,
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